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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/054,684	01/22/2002	Francis James Canova JR.	035451-0132 (3645.Palm)	5151

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EXAMINER

SHENG, TOM V

ART UNIT	PAPER NUMBER
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2673

DATE MAILED: 06/17/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/054,684

Applicant(s)

CANOVA, FRANCIS JAMES

Examiner

Tom V Sheng

Art Unit

2673

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 March 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

2. Claim 6 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

As for claim 6, lines 2-3, it is not clear what are the sets of text items according to the applicant, since the phrase "text items" are not in the specification. Clarification is requested.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Henry, Jr. (US 5,881,169).

As for claim 1, Henry teaches a handheld computer system (figures 1, 3, 5; portable computing device), comprising:

a switch (a switch on the computing device);

Art Unit: 2673

a user interface (display screen 120/400 with different text input/selection fields);
a housing (shown outside the display screen 120); and
a display supported by the housing (display screen 120/400),
wherein the user interface includes a text information entry area (individual character selection field 220),

wherein the text information entry area is activated in response to manipulation of the switch (display when invoked), the switch being a switch device located outside of the display (this switch is outside the display screen versus an equivalent activation area 411 on the display screen). See column 2, line 65 through column 3, line 12; column 3, lines 31-44; and column 4, lines 34-61.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 2-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Henry as applied to claim 1 above, and further in view of Danielson et al. (US 5,805,474).

As for claim 2, Henry teaches displaying the individual character selection field 220 for text entry when activated by the switch. Henry does not teach wherein the text information entry area is deactivated in response to manipulation of the switch.

Art Unit: 2673

Danielson teaches a portable data collection terminal with a switch 472, wherein in one mode an internal scanner is activated when the switch is depressed and released and is deactivated when the switch is depressed and released a second time (figure 29 or 30; column 25, lines 49-57).

It would have been obvious for one of ordinary skill in the art at the time the invention was made to incorporate Danielson's switching method into Henry's switch, since this is a very common and straight-forward way of using a switch (called toggling) in activating and deactivating a particular operation.

As for claim 3, Danielson's first press and release on the switch reads on claimed first manipulation and second press and release reads on claimed second manipulation.

As for claims 4-5, a squeeze switch and a button are both common switch mechanisms.

As for claim 6, Henry teaches also character input area 160 and anticipated character selection field 240 that could be used in any combination with the individual character selection field 220 so as to be activated (popped-up) together.

As for claim 7, Henry teaches that the selection field 240 can be varied in size by dragging the periphery of the field. Obviously, it would be an alternative to activate and deactivate this field 240 instead of field 220 together with this size-changing feature.

7. Claims 8-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Henry in view of Danielson.

Art Unit: 2673

As for claims 8 and 12, Saitoh teaches a user interface for a handheld computer system, the handheld computer system (figures 1, 3, 5; portable computing device) comprising a display (display screen 120/400) and a touch pad (underlying pressure sensitive areas for input or selection),

the user interface comprising:

means (individual character selection field 220) for receiving information at the touch pad and the display;

means (field 220 showing an exhaustive list of characters 230a, 230b, 230c, etc. available for entry) for receiving a display in a graphical user interface to prompt a user to input text information (characters).

Further Henry teaches a means (a switch on the computing device or activation area 411) for activating the means for receiving and that the means is not located on the display (this switch is outside the display screen versus the equivalent activation area 411 on the display screen). See column 2, line 65 through column 3, line 12; column 3, lines 31-44; and column 4, lines 34-61.

However, Henry does not teach the same means for deactivating the means for receiving, and wherein the means for receiving is reduced in size or removed from the display when deactivated and the means for activating and deactivating is not located on the display.

Danielson teaches a portable data collection terminal with a switch 472, wherein in one mode an internal scanner is activated when the switch is depressed and released

Art Unit: 2673

and is deactivated when the switch is depressed and released a second time (figure 29 or 30; column 25, lines 49-57).

It would have been obvious for one of ordinary skill in the art at the time the invention was made to incorporate Danielson's switching method into Henry's switch, since this is a very common and straight-forward way of using a switch (called toggling) in activating and deactivating the selection field 220. When deactivated, the individual character selection field 220 would naturally be removed versus being displayed when activated.

As for claim 9, Henry's individual character selection field 220 reads on claimed pictorial representation of a keyboard or an area assigned for entering text information.

As for claims 10-11, Henry's character input area 160 could similarly be used in place of the individual character selection field 220 as the field for activation and deactivation.

Claim 13 is rejected per analyses of claims 8-12 and 5.

As for claims 14-15, Henry's switch is inherently integrated into the housing.

As for claims 16-17, it is a basic convenience to provide a specific symbol at the switch to designate the function of the switch.

Method claims 18-22 correspond to apparatus claims 8-17 and are rejected accordingly. Here, Henry's switch outside the display screen reads on claimed mechanical switch and Henry's activation area 411 on the display screen reads on claimed touching sensor.

Response to Arguments

8. Applicant's arguments with respect to claims 1-22 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tom V Sheng whose telephone number is (703) 305-6708. The examiner can normally be reached on 8:30am - 5:00pm.

Art Unit: 2673

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bipin Shalwala can be reached on (703) 305-4938. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Tom Sheng
June 10, 2004


KENT CHANG
PRIMARY EXAMINER